

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
KLADDERS, Heinrich, et al.

Application No.: 10/757,047

Filed: January 14, 2004

For: **CAPSULE FOR TAKING AN ACTIVE
SUBSTANCE WHICH CAN BE INHALED**

Group Art Unit: 3771

Examiner: DOUGLAS, Steven O

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Commissioner of Patents
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**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

Sir:

This is a request for reconsideration of the patent term adjustment indicated in the Issue Notification mailed on January 12, 2011, and U.S. Patent No. 7,878,193 issued on February 1, 2011.

This request is being filed pursuant to 37 C.F.R. § 1.705(d) in compliance with the requirements of 37 C.F.R. § 1.705(b)(1) and (b)(2). This request is being filed within two months of the date the patent issued, and therefore is timely filed under 37 C.F.R. § 1.705(d). Pursuant to 37 C.F.R. § 1.705(b)(1), the required fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) is included herewith. Pursuant to 37 C.F.R. § 1.705(b)(2), a statement of the facts involved is set forth below.

The Office calculation was for 912 days of PTA. As summarized below, applicants believe the correct PTA to be 1185 days.

Pursuant to 37 C.F.R. § 1.705(b)(2)(i), below is an indication of the correct patent term adjustment and the basis or bases under § 1.702 for the adjustment:

Correct Patent Term Adjustment (PTA) = 1185 days

Bases for the above PTA

- (A) 764 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1);
plus
(B) 165 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3);
plus
(C) 273 days of Office “B” delay under 37 C.F.R. §§ 1.702(b) and 1.703(b);
minus
(D) 17 days of Applicant delay under 37 C.F.R. § 1.704(b).

Total PTA = (A) 764 days + (B) 165 days + (C) 273 days - (D) 17 days = 1185 days.

Pursuant to 37 C.F.R. § 1.705(b)(2)(ii), below is an indication of the relevant dates specified in 37 C.F.R. § 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703 (f) to which the patent is entitled:

(A) 764 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1)

The 764 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) is calculated based on the following dates:

- (1) The day after the date that is 14 months after the date on which the application was filed under 35 U.S.C. 111(a) = March 15, 2005;
- (2) The date of mailing of the first action under 35 U.S.C. 132 = April 17, 2007;
and
- (3) The number of days beginning on March 15, 2005 and ending on April 17, 2007 = 764 days.

(B) 165 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3)

The 165 days of Office “A” delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3) is calculated based on the following dates:

- (1) A reply to Office Action was filed on April 21, 2008;
- (2) The day after the date that is 4 months after the date on which the reply to Office Action was filed = August 22, 2008;
- (3) A Notice of Allowance was not mailed until February 2, 2009, which was beyond the 4-month period specified in 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3);
and
- (4) The number of days beginning on August 22, 2008 and ending on February 2, 2009 = 165 days.

(C) 273 days of Office “B” delay under 37 C.F.R. §§ 1.702(b) and 1.703(b)

The 273 days of Office “B” delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3) is calculated based on the following dates:

- (1) The day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) = January 15, 2007;
- (2) The date the first Request for Continued Examination was filed under 35 U.S.C. 132(b) = January 15, 2008, however, the applicants note the Office incorrectly input a filing date of January 15, 2007, in line numbers 39 and 37 of the Patent Term Adjustments section of the PAIR system;
- (3) The number of days beginning on January 15, 2007 and ending on January 15, 2008 = 366 days of Office “B” delay;

(4) 93 days of the 366 days of the Office “B” delay beginning on January 15, 2007 and ending on April 17, 2007 fall on the same calendar day, and therefore overlap with the Office “A” delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) discussed above; and

(5) in accordance with the Federal Circuit’s interpretation of 35 U.S.C. § 154(b)(2)(A) in *Wyeth v. Kappos*, the 93 overlapping days between the Office “A” and “B” delays in which the Office “A” and “B” delays occurred on the same calendar day reduce the summation of the number of days calculated for the Office “A” and “B” delays, therefore the Office “B” delay results in 366 days – 93 overlapping days = 273 days.

The PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled

As specified in 37 C.F.R. § 1.703(f), the term of a patent entitled to adjustment under §§ 1.702 and 1.703 shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of § 1.703, to the extent such periods are not overlapping, less the sum of the periods calculated under § 1.704.

For the instant application the sum of the periods under paragraphs (a) through (e) of § 1.703 is 1202 days, calculated as follows:

(A) 764 days delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1);

plus

(B) 165 days delay under 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(3);

plus

(C) 273 days delay under 37 C.F.R. §§ 1.702(b) and 1.703(b).

For the instant application the sum of the periods calculated under 37 C.F.R. § 1.704 is

17 days, as follows:

(D) 17 days under 37 C.F.R. § 1.704(b). A Final Office Action was issued on October 4, 2007, to which a response was not filed until January 15, 2008, which was 11 days beyond the 3-month period specified in § 1.704(b) - thus, a 11 day reduction. Additionally, a Final Office Action was issued on October 27, 2009, to which a response was not filed until February 2, 2010, which was 6 days beyond the 3-month period specified in § 1.704(b) - thus, a 6 day reduction.

Therefore, the PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled is 1185 days, calculated as follows:

1202 days (the sum of the periods under paragraphs (a) through (c) of § 1.703)
minus
17 days (the sum of the periods calculated under § 1.704)
= 1185 days

With respect to 37 C.F.R. § 1.705(b)(2)(iii), the resulting patent issued on the instant application is not subject to any terminal disclaimers.

With respect to 37 C.F.R. § 1.705(b)(2)(iv), there were circumstances during prosecution of the instant application constituting failure to engage in reasonable efforts to conclude processing or examination of the application under 37 C.F.R. § 1.704. These circumstances are as outlined above under (D) resulting in the following PTA reduction: 17 days under 37 C.F.R. § 1.704(b) [for responses filed January 15, 2008 and February 2, 2010], for a total of PTA reduction of 17 days.

Accordingly, Applicants respectfully request that the PTA specified in the Issue Notification mailed on January 12, 2011, and the Issued Patent No. 7,878,193 issued on February 1, 2011, (stated therein to be 912 days) be corrected to 1185 days for the reasons as outlined above.

The Commissioner is hereby authorized to charge any additional fees associated with this response or credit any overpayment to Deposit Account No. 11-0223.

Respectfully submitted,

Dated: March 2, 2011

s/Jason S. Ngui/
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